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Subject: U.S. TRADEMARK APPLICATION NO. 86321169 - GOLDENBERRY - Volcano-TM-0 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86321169

MARK: GOLDENBERRY

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GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

TTAB INFORMATION:

http://www.uspto.gov/trademarks/process/appeal/index.jsp

APPLICANT: Volcano Produce, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

Volcano-TM-0

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, Volcano Produce, Inc., has appealed the trademark examining attorney's final refusal to register the mark **GOLDENBERRY** in standard characters for "fresh fruits" pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), on the grounds that the mark is merely descriptive of the applied-for goods.

I. FACTS

On June 26, 2014, Volcano Produce, Inc. applied for the mark GOLDENBERRY in connection with "fresh fruit" in International Class 31 on the Principal Register.

On October 9, 2014, registration was refused pursuant to Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127, for the applied-for mark being a varietal name of a type of fruit, as well under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1127 for failure to provide a specimen of use for an application filed under Section 1(a) of the Trademark Act. In addition, a requirement for information about the goods was issued under 37 C.F.R. §2.61(b).

On April 9, 2015, applicant responded to the initial Office action and provided a specimen of use and responded to the information requirement under 37 C.F.R. §2.61(b).

On April 29, 2015, based on applicant's response, the varietal refusal under Trademark Act Sections 1, 2, and 45 was withdrawn. However, a refusal under Section 2(e)(1) was issued for the applied-for mark being merely descriptive. In addition, applicant's specimen was refused under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1127.

On October 29, 2015, applicant responded to the subsequent Office action by providing a substitute specimen of use.

On November 18, 2015, the trademark examining attorney issued a final Office action under Section 2(e)(1) of the Trademark Act and withdrew the Section 1, 2 and 45 refusal based on applicant's substitute specimen.

On January 11, 2016, applicant filed a request for reconsideration of the Section 2(e)(1) refusal, which was denied on February 1, 2016.

On May 13, 2016, applicant filed the instant appeal.

II. ISSUE ON APPEAL

The sole issue on appeal is whether applicant's mark is merely descriptive of the applied-for goods under Section 2(e)(1) of the Trademark Act.

Applicant states that the mark was refused in the alternative for being generic in the April 29, 2015, Office action; however, the section referred to by the applicant was not a refusal, rather it was an advisory indicating that because the mark *appeared* to be generic, no amendment to proceed under Trademark Act Section 2(f) nor an amendment to the Supplemental Register could be recommended. *See* Applicant's Brief p. 2. Applicant has never amended the application to the Supplemental Register nor has the instant application ever been refused under Section 23(c) of the Trademark Act. *See* TMEP 1209.02(a).

III. ARGUMENT

GOLDENBERRY, WHEN USED IN CONNECTION WITH APPLICANT'S GOODS, IS MERELY DESCRIPTIVE OF A FEATURE OF APPLICANT'S GOODS

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods. TMEP §1209.01(b); *see, e.g.*, *In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)).

A. Applicant's Mark is Merely Descriptive of a Feature of Applicant's Goods

Here, applicant's mark is GOLDENBERRY in connection with "fresh fruits." GOLDEN is defined as "colored or shining like gold" and "having a deep yellow color of gold." *See* the definition from the Oxford Dictionaries and Merriam-Webster, respectively, February 1, 2016 Request for Reconsideration pp.5-6, 14-15. BERRY is defined as "a small roundish juicy fruit without a stone" and "a small fruit…that has many small seeds." *See id.* at pp. 2-3, 8-9. Thus, applicant's mark conveys that the goods are berries that are golden in color. In fact, applicant's goods are berries that are golden in color. *See* Applicant's

Specimen submitted on October 29, 2015. Moreover, applicant concedes that "[t]he fruit is a berry…" Applicant's Brief p. 12. However, applicant contends the goods are "yellow in color" and that "[t]here is no 'golden' color." *Id.* On the other hand, multiple dictionary definitions of record indicate that golden is a shade of yellow. Further, applicant also states in its brief, "[t]o be sure, there are many kinds of berries and, as discussed, *infra*, many are yellow or golden in color." *Id.* at p. 13. Thus, applicant's mark is merely descriptive of a feature of the goods.

Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods, the combination results in a composite mark that is itself descriptive and not registrable. *See, e.g., In re Leonhardt*, 109 USPQ2d 2091 (TTAB 2008) (BOBBLE POPS held merely descriptive for "candy," which the record showed was a lollipop candy featuring a bobble head device); *In re Cox Enters.*, 82 USPQ2d 1040, 1043 (TTAB 2007) (holding THEATL merely descriptive of publications featuring news and information about Atlanta where THEATL was the equivalent of the nickname THE ATL for the city of Atlanta). Here, the components of the mark comprise a nickname for the type of fruit offered by the applicant. Applicant's packaging states "goldenberry, also known as uchuva, cape gooseberry or physalis peruviana, is a super fruit native to South America," which implies that "goldenberry" is one of several names by which the fruit is known. See October 29, 2015, Response to Office action, p.2. Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods is the combined mark registrable. *See In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013). In this case, both the individual components and the composite result are descriptive of applicant's goods and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods. Moreover, applicant has not put forth any alternative meanings of the mark that are not merely descriptive of the goods. As a result, applicant's mark is merely descriptive of applicant's goods.

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